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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/611,330	07/01/2003	Katsuichi Osakabe	P 304062	3818

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EXAMINER

HUBER, PAUL W

ART UNIT	PAPER NUMBER
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2653

DATE MAILED: 07/07/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/611,330

Applicant(s)

OSAKABE, KATSUICHI

Examiner

Paul Huber

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 25 August 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 18-47 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 30-33, 35-37 and 43 is/are allowed.
- 6) ☒ Claim(s) 18-29, 34, 38-42 and 44-47 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☒ Certified copies of the priority documents have been received in Application No. 09/412,736.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 070103; 082503
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

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The title of the invention is not descriptive. A new title is required that is clearly indicative of the invention to which the claims are directed.

The specification has not been checked to the extent necessary to determine the presence of all possible minor errors. Applicant's cooperation is requested in correcting any errors of which applicant may become aware in the specification.

Claims 20-23 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 2 of U.S. Patent No. 6,894,961. Claims 25 and 42 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 3 of U.S. Patent No. 6,894,961. Claims 26 and 27 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 4 and claim 5, respectively, of U.S. Patent No. 6,894,961. Although the conflicting claims are not identical, they are not patentably distinct from each other because as noted by the Federal Circuit in *Eli Lilly v. Barr*, "[a] patentable distinction does not lie where a later claim is anticipated by an earlier one." See also *In re Berg* and *In re Goodman* which established that a later genus claim limitation is anticipated by, and therefore not patentably distinct from, an earlier species claim.

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 18, 19, 24, 28, 29, 34, 38-41, 45 and 46 are rejected under 35 U.S.C. 102(b) as being anticipated by Yoshida et al. (USP-5,764,610).

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Yoshida et al. discloses reproducing, from among disk readout signals generated by reading an optical disk to be recorded on, information (wobble signal) indicative of a type and maker of an optical disk to be recorded, i.e., DVD-R format or CD-R format, the information being pre-recorded on a track of the optical disk during manufacture of the optical disk. See figure 5; steps 501-508; col. 7, lines 45-64. "It is noted that when the disc 1, is determined to be of the CD-R format type ... in Step 508 ..., the system control circuit 8 outputs a switching signal for switching from the rotation control circuit 14 to the rotation control circuit 13 to the switch 12 so as to rotate the disc at a speed of four times that of the linear speed of the CD format" (col. 8, lines 23-29). The rotation control circuit 14 for the DVR-R format type disc (in Step 507) rotates the disc at the linear speed of the DVD format. Accordingly, Yoshida et al. further discloses reproducing, from among disk readout signals generated by reading an optical disk to be recorded on, disk-applicable-recording-speed information (wobble signal) pre-recorded on a track of the optical disk during manufacture of the optical disk. A control means performs recording on the optical disk (inherent function of "recording/playback unit" of DVD-R or CD-R; see col. 2, lines 46-51) after setting a recording speed for the optical disk to a predetermined speed value within a range specified by the reproduced disk-applicable-recording-speed information (wobble) as claimed.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 44 and 47 are rejected under 35 U.S.C. 103(a) as being unpatentable over Yoshida et al., as applied to the claims above, in further view of Fukuda et al. (USP-6,445,658).

Yoshida et al. discloses a recordable optical disk as claimed, including disk-applicable-recording-speed information indicative of applicable recording speeds for the optical disk prerecorded in pre-groove wobbles, but fails to specifically recite that the disk-applicable-recording-speed information is capable of being reproduced as disk-applicable recording speed displayed on a display device. However, Fukuda et al. discloses an optical disk device which includes "a display 68 (FIG. 12) for displaying the result of eccentricity determination and/or operational speed can be provided," in the same field of endeavor, "so as to let a user know the result of detection and/or adjustment" (col. 16, lines 4-16).

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It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Yoshida et al. such that the disk-applicable-recording-speed information is capable of being reproduced as disk-applicable recording speed displayed on a display device, as taught by Fukuda et al. A practitioner in the art would have been motivated to do this in order to indicate to a user through a display device the operational speed of the detected disk for informational purposes.

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Yokogawa, Sugimoto et al. and Ashinuma et al. each disclose an apparatus/method for detecting the type of recording medium.

Claims 20-23, 25-27 and 42 would be allowable if a terminal disclaimer is timely filed as explained above.

Claims 30-33, 35-37 and 43 are allowed.

The following is an examiner's statement of reasons for allowance: the prior art of record considered as a whole fails to teach or suggest either:

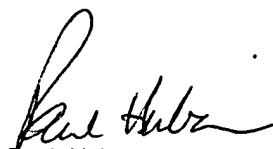
1) an optical disk recording device or method for recording on an optical disk where disk-applicable-recording speed information is incorporated in at least one of lead-in start time information and lead-out start time information recorded in pregroove wobbles or pre-pits of the optical disk during manufacture of the optical disk, the optical disk recording device or method comprising: time information reproducing means/step for reproducing, from among disk readout signals generated by reading the optical disk to be recorded, at least one of the lead-in start time information and the lead-out start time information recorded in the pregroove wobbles or pre-pits of the optical disk during manufacture of the optical disk; and **control means/step for determining disk-applicable recording speeds based on at least one of the lead-in start time information and the lead-out start time information reproduced by the time information reproducing means, and for performing recording on the optical disk after setting a recording speed for the optical disk to a speed value within a range of the determined disk-applicable recording speeds**; or

2) an optical disk recording device or method, comprising: disk-applicable-recording speed information reproducing means/step for reproducing, from among disk readout signals generated by reading an optical disk to be recorded on, disk-applicable-recording-speed information pre-recorded on a track of the optical disk during manufacture of the optical disk; **display means/step for displaying disk-applicable recording speeds based on the disk-applicable-recording-speed information reproduced by the disk-applicable-recording-speed information reproducing means**; recording speed designating means/step for designating a particular

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recording speed value based on an operation by a user; and control means/step for performing recording on the optical disk after setting a recording speed for the optical disk to the particular recording speed value designated by the recording speed designating means. (bold language emphasized)

Any inquiry concerning this communication should be directed to Paul Huber at telephone number 571-272-7588.

A handwritten signature in black ink, appearing to read "Paul Huber", with a stylized, flowing script.

Paul Huber
Primary Examiner
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pwh
July 6, 2005